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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,972	01/30/2004	Patrick Cruchet	DNAG-275	4547

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

Office Action Summary	Application No. 10/768,972	Applicant(s) CRUCHET ET AL.	
	Examiner Dave Willse	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 10, 2007, is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The abstract of the disclosure is objected to because on the second line of the text, a comma should follow “shaft”. Correction is required (MPEP § 608.01(b)).

The disclosure is objected to because there is no mention of reference characters **20** and **21**, newly added to Figures 2 and 5 in the replacement drawings of January 10, 2007.

Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

On page 2, lines 23-25, the slide pairing diameter differences being on the order of *micrometers* appear to contradict the ratios and absolute values set forth on page 2, lines 8-12, which suggests diameter differences on the order of *millimeters* or tens of millimeters. Perhaps the micrometer values are intended to be associated with contacting surfaces or parameters on manufacturing tolerances or surface roughness, but such is inadequately conveyed to the ordinary practitioner. The Applicant’s remarks arrive at an exemplary value of 9.8 *millimeters*, which only underscores the confusing nature of the disclosure, since the Applicant’s own calculated value is at least two orders of magnitude greater than the *micrometer* ranges specified at page 2, lines 23-25, of the specification. The Applicant’s partial clarification (via the replacement drawings) of how the slide pairing diameters are to be interpreted, without resolving the overall issue, necessitate prior art rejections of other dependent or formerly dependent claim limitations, as set forth below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, "the diameters" lacks a proper antecedent basis. Claim 3 contradicts claim 2, because even the extreme limits (14 mm and 40 mm) of the respective ranges do not yield a ratio of "5" (claim 2, line 3). In claim 4, lines 1-2 lack proper syntax. Claims 12, 13, 17, and 20 are identical to claims 2, 3, 7, and 10. In claim 11, both lines 2 and 3 lack proper syntax. *Other errors were noted.*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 11, 16, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bouvet, EP 0 461 019 B1: Derwent abstracts; Figures 1 and 2. Regarding claim 1, Figure 1 depicts the diameter of the outer slide surface of the bipolar shell **8** and **15** to be about twice the diameter of the ball head **2** so that the ratio as claimed is approximately two, which clearly falls within the specified range. Regarding claims 11 and 21, the bipolar shell can alternatively be interpreted as the cup **8** only, said cup being monolithic and of a single material; nothing in present claim 11 requires that the bipolar shell directly contact the ball head.

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Claims 2, 3, 7, 10, 12, 13, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouvet, EP 0 461 019 B1. Regarding claim 2, the aforementioned ratio being 5 would have been an obvious variant in view of the curvature radius of the cavity **12** being “considerably smaller” than the curvature radius **43** of the cavity **5** (second Derwent abstract, lines 5-6 and 11-13) and in the absence of any disclosed criticality for this particular value (*In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)). The dimensions set forth in claims 3, 7, and 10 would have been obvious for similar reasons, with the ordinary practitioner having been aware of the range of hip joint sizes in human and animal anatomies.

Claims 1, 11, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by McLean, US 2002/0116068 A1: Figures 12 and 13; paragraphs **0009**; **0050**; and **0051**. Regarding claim 1, the outer diameter of the inner shell **78** is illustrated to be well over 1.05 times the ball head **76** diameter.


Claims 2, 3, 5, 7, 9, 10, 12, 13, 15, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLean, US 2002/0116068 A1. The further limitations of claims 2, 3, 7, and 10 would have been obvious for reasons similar to those given above. Regarding claim 5 and others, an offset of between 1.5 and 2.5 mm for the center of rotation **37** relative to the shell center **39** (Figures 10 and 11) would have been obvious to the ordinary practitioner using routine experimentation in order to optimize range of motion (paragraph **0048**), particularly in the absence of any disclosed criticality for such a range (*In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)).

The Applicant’s comments have been reviewed and are adequately addressed above. The Applicant’s response necessitated the modified grounds of rejection. Therefore:

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Dave Willse
Primary Examiner
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